

REMARKS

Claims 1-4 and 6 remain pending in the application. Independent claim 1 is currently amended to claim a lower limit of 15 for the value of “n”, support for which can at least be found in Example 6 in paragraph [0045] on page 18 of the instant application as filed. No claims are cancelled or added. Claims 5 and 7 were previously cancelled. No new matter is added through the instant Amendment.

Claims 1 and 6 stand rejected under 35 USC §103(a) over Mine et al. (USPN 5872170). Claims 2-4 have been objected to as being dependant from a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicants respectfully request the Examiner to reconsider the rejections of independent claim 1 as obvious over Mine et al. in view of the instant amendment to independent claim 1.

In response to the final Office Action, the Applicants filed a Response After Final, in which it was argued that silicone oils having only 5 silicon atoms (as specifically taught in the Examples of Mine et al.) are not capable of forming a homogeneous composition in the conditions presented in the Examples of the instant application (see Comparative Example 2), whereas similar silicone oils having greater numbers of silicon atoms were shown to successfully form homogeneous compositions. On this basis, the Applicants argued in favor of the criticality of the value of “n” for purposes of successfully forming homogeneous compositions, with Examples and Comparative Examples contained in the instant application providing evidence to this effect.

In the Advisory Action issued by the Examiner, the Examiner did not challenge the Applicants' assertion or position that the value of "n" is shown to be critical in the Examples of the instant application. Rather, the Examiner took the position that the claimed range of values for "n" in independent claim 1 of from 5 to 100 is not shown to be critical (in particular with regard to the value of 5 for "n", corresponding to a total number of 7 silicon atoms present in the silicone oil) because none of the Examples demonstrate the criticality of the lower limit of Applicants' claimed range of 5 to 100 for "n".

Of particular relevance to the instant analysis is the treatment of claimed ranges under the 35 U.S.C. §103 obviousness standards, which are addressed in MPEP 2144.05. In general, in the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior art" a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Notably, **Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range, generally by showing that the claimed range achieves unexpected results relative to the prior art range.** See MPEP 2144.05(III).

The Applicants respectfully submit that, in view of the lower limit for "n" now claimed to be 15 instead of 5, the criticality of the lower limit claimed for "n" is now fully demonstrated by the Examples (in particular, Example 6 specifies a silicone oil having a value for "n" of 15, with the resulting silicone oil having a total of 17 silicon atoms). Unexpected results are clearly proven for the scenario of when "n" is 15 (with the resulting silicone oil having 17 silicon atoms) versus a scenario of when "n" is 3 (with the resulting silicone oil having 5 silicon atoms).

as represented in the Examples of Mine et al). In particular, a homogeneous composition is shown to be formed when the silicone oil has 17 silicon atoms in Example 6, whereas silicone oil having 5 silicon atoms is incapable of producing a homogeneous composition (see Comparative Example 2). The Applicants respectfully submit that, on this basis alone, the Applicants have shown the criticality of the value of “n” within the complete range for the value of “n” claimed in independent claim 1 such that the Applicants have overcome the Examiner’s *prima facie* case of obviousness against independent claim 1 over Mine et al. As such, the Applicants respectfully submit that this rejection must be withdrawn.

In addition to the above, the Applicants’ have previously argued that specific examples of Mine et al. are more indicative of the actual teachings thereof than broad disclosures of all manner of adhesion-promoting agents provided in column 17, line 28 to column 18, line 27, and are more useful to determine how one of skill in the art would have reasonably interpreted the broad teachings of Mine et al. The Examiner has responded by indicating that a reference may be relied upon for all that it teaches, including non-preferred embodiments, which the Applicants acknowledge and readily appreciate. However, the operative language is that a reference can be relied upon for all that it teaches, with the ultimate question in this case being whether or not a broad listing of compounds covering countless subspecies is sufficient to teach a person of skill in the art to use specific subspecies that are not specifically disclosed. Recent case law provides cautionary guidance to Examiners against utilizing impermissible hindsight when performing obviousness analyses, particularly when the prior art presents countless identifiable possible solutions only a few of which meet the limitations of the claims at issue

(see *Takeda Chem. Indus. v. Alphapharm Pty. Ltd.*, 492 F.3d 1350 (Fed. Cir. 2007) and *Ortho-McNeill Pharm. Inc. v. Mylan Labs, Inc.*, 520 F.3d 1358 (Fed. Cir. 2008)). The Examiner is urged to adhere to the proper standards as recited in *Takeda* and *Ortho-McNeill* should the Examiner wish to maintain the rejection relying on selection of the specifically claimed silicone oils from the countless possibilities set forth in *Mine et al.*

Further to the Applicants' position that *Mine et al.* does not adequately teach a person of skill in the art to employ the specifically claimed silicone oils have the claimed values for "n", the Applicants reassert that *Mine et al.* specifically describes other silicone oils, such as methyltrimethoxysilane, as equally suitable as other silicone oils described therein, such as the silicone oils represented by the formula in column 17, lines 40-47 that the Examiner has used as a basis for equation to the instantly claimed silicone oils. It is very relevant that the Comparative Examples contained in the instant application prove that methyltrimethoxysilane is incapable of successfully forming homogeneous compositions, whereas identical amounts of silicone oils in accordance with claim 1 of the instant claims enabled successful formation of homogeneous compositions. This is a further indicia of non-obviousness of the instantly claimed silicone oils. In particular, the Applicants respectfully submit that the fact that *Mine et al.* directs a person of skill in the art to employ silicone oils that are specifically proven to be ineffective for purposes of the instant invention is indicative of non-obviousness of the instantly claimed silicone oils. This remains the case even though *Mine et al.* must be considered for all that it teaches; the fact that *Mine et al.* focuses on silicone oils (as represented by the Examples that *Mine et al.* chose to highlight out of the countless possible silicone oils embodied by the

broad disclosure therein) that are ineffective for purposes of attaining a homogeneous composition is equally a teaching that must be considered along with the broad disclosure of countless silicone oils within Mine et al., and the specific teachings of Mine et al. as represented by the Examples are highly representative of the actual scope of the teachings of Mine et al.

In view of the foregoing, the Applicants respectfully submit that independent claim 1, as amended, is both novel and non-obvious over the teachings of Mine et al. As such, the Applicants respectfully submit that independent claim 1 is in condition for allowance, which allowance is respectfully requested.

This Amendment is timely filed with the appropriate fee for a Request for Continued Examination (RCE). While it is believed that no further fees are presently due, if necessary, the Commissioner is authorized to charge Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys PLLC for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

April 9, 2009

Date

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